

PA 7530

Atty

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

HAND CARRY: GROUP 2757

BEASLEY, et al

Atty. Ref.:

Serial No.: 08/969,723

Group: 2757

Filed: November 12, 1997

Examiner: Dinh, D.

For: Interconnection System for Viewing and Controlling
Remotely Connected Computers with On-Screen Video
Overlay for Controlling of the Interconnection Switch

Received
FEB 24 1999
Group 2700

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February 24, 1999

Assistant Commissioner for Patents
Washington, DC 20231

RECEIVED

MAY 06 1999

**REPLY TO OPPOSITION TO PETITION
TO WAIVE THE RULES AND PROTEST**

Group 2700

Sir:

I. Introduction

*Mailed fm
5/21/99*

On February 17, 1999, Cybex received a copy of Apex's "Opposition to Petition to Waive the Rules and Protest Under 37 CFR 1.291" (hereafter, "the Opposition") and for the first time saw the initialed IDS and Supplemental Notice of Allowability attached to it. Because Apex chose for several months to hide this information from Cybex, Cybex could not address it in the pending Protest. Apex's

service of its Opposition affords Cybex the opportunity now to offer the following information related to it for the Group Director's consideration.

Apex's Opposition rests upon the premise that the examiner of the present patent application "already considered the '212 patent" (Opposition at 2)(emphasis in original). But, the IDS relied upon in Apex's Opposition is a five page line-by-line listing of a hundred references, including sixty-seven U.S. Patents, six foreign patents, and twenty-seven other document references. No examiner could have "considered" the '212 patent when Apex had it buried in a box of paper.

Cybex also respectfully submits that Apex improperly filed the IDS without the certificate required by 37 CFR 1.97(d-e), leaving the examiner to "consider" this parade of paper in only a couple of days at most. Moreover, although Apex never apprised the PTO of the reason for the relevance of the '212 patent, Apex has essentially admitted in Court that the '212 patent will result in the US PTO granting an interference.

II. The Apex IDS Was Not Properly Submitted.

Subsections (b) through (d) of 37 CFR 1.97 do not permit the filing of an IDS unless either done before the mailing of the Notice of Allowance or with a certification described in subsection (e). Here, Apex filed their IDS on November 25, 1998, two weeks after the Notice of Allowance was mailed (on November 12,

1998), not "before" it. Under those circumstances, Apex was required by 37 CFR 1.97(d) to file a certification under subsection (e) stating that the IDS listed only items "cited in a communication from a foreign patent office" or only items that were not "known to any individual designated in §1.56(c) more than three months prior to the filing of the information disclosure statement."

Apex did neither. They did not submit their IDS before the Notice of Allowance and did not provide the requisite certification. The IDS was improper.

III. Apex's Haste Precluded Proper Consideration of the '212 Prior Art.

On December 4, 1998, only five days after the tardy IDS arrived at the Group (November 30, 1998), the Examiner initialed the one-hundred references listed. It is not unreasonable to assume that Apex's tardiness left the examiner with at most a couple of days to consider the entire listing of one-hundred references, which in total had to amount to at least a box of paper. The '212 patent itself is 64 columns of text, 255 of pages of Appendix, and 64 figures. And, the examiner would have most likely had to read all the way to column 44 of the '212 patent before finding the "menu option" that is critically relevant to the overlaid video aspects of the patent application presently under protest.

Of course, Apex has known during the pendency of the application at issue that the '212 patent is being used as a basis to show invalidity of the parent '842 patent claims. Still, Apex never chose to tell the examiner of this fact, nor to highlight to the examiner that the '212 patent may be worthy of particular consideration. Rather, Apex did the opposite: it buried the reference among a hundred others, and then never told the examiner that it was the substance of a direct invalidity attack. To the best of Cybex's knowledge, Apex has not yet provided the examiner with a copy of Cybex's Summary Judgment Motion of Invalidity of the '212 patent or any of the supportive exhibits.

Apex's arguments premised upon previous "consideration" of the '212 patent should be dismissed as wrong and inequitable given Apex's attempt to slide the '212 patent past the examiner without identifying to the examiner that it, among the hundred references, may have been of particular importance. The Patent Rules preclude the exact conduct that Apex engaged in to get the '212 patent quickly past the examiner's attention.¹

¹ Recently proposed PTO rules presently under consideration also would have prevented Apex's "hide the ball" tactics by requiring them to state the relevance of any references that they included in an IDS submitting more than ten items. See attached Federal Register Volume 63, Number 192, at pages 53512-16.

IV. Cybex Could Not Have Brought the Protest Earlier.

Apex's casting of aspersions at Cybex for "delay in filing" is disingenuous. Cybex did not "choose" to wait to file the protest, it was required to by court order. Petition at 5. As Apex is well aware, Cybex's attorneys were not free to use knowledge of the continuation application until after the November 12, 1998 Notice of Allowance had already been mailed by the examiner.² In fact, Apex—not Cybex—was the party responsible for the delay since Apex alone had the power to clear the present application papers from their confidential status, thus opening the door for Cybex to file its protest earlier. Since Apex did not do so until after the November 12, 1998 Notice of Allowance was mailed, Cybex could not have filed the protest before that mailing. The Petition is proper and should not be denied based on Apex's spurious arguments of "delay."

V. Apex's Arguments Are Inconsistent.

Although Apex's attorney argues in the Opposition that the '212 patent was already considered and that the present application should be allowed to issue, those arguments are inconsistent with Apex's corporate position. Apex has agreed by

² Apex's argument that Cybex could have used the publicly available serial number to file a protest is absurd. A protest simply identifying a prior art reference together with a pending serial number, without addressing how the prior art applies to the pending application, would undoubtedly face a cold reception at the patent office. When Cybex was finally in a position to non-confidentially disclose the substantive link between the present patent application and the '212 prior art, it quickly filed the present protest.

stipulation that it believes that Cybex's pending Request for Interference between the '212 patent and the '842 patent "will be granted." See attached stipulation at ¶ 3. Apex and Cybex have stipulated in court that:

"The Parties expect that Cybex's request to have an interference proceeding commenced in the PTO will be granted." (emphasis added).

Apex even stipulated that the interference would be granted where:

"Cybex intends to seek in the PTO a judgment . . .
(b) holding that the claims in any continuation of the '842 patent involved in the interference are unpatentable."
(emphasis added).

On the one hand, the Apex Opposition ratifies Apex's improper tactic of forcing the examiner's expedited review of the one-hundred references in the subject IDS (to whitewash the present application into allowance over the '212 patent). On the other hand, Apex has admitted that the '212 patent is relevant and material enough to provoke an interference over "any continuation of the '842 patent" (i.e., the present application at issue). Apex's argument that the '212 patent "was considered" belies its true knowledge that the '212 patent is highly relevant to the continuation application and will likely be the subject of an PTO interference therebetween.

VI. Conclusion

Apex has never properly presented the '212 patent to the examiner. The only method that Apex has chosen to give the examiner the '212 patent was by burying it in a tardy IDS and then apparently pressing the examiner to consider it, together with a hundred other references, in only a day or two. Cybex respectfully submits that the present application does not cover patentable subject matter and requests that it be withdrawn from issuance and examined as part of Cybex's pending request for interference.

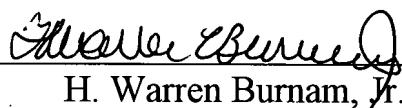
Respectfully submitted,
NIXON & VANDERHYE P.C.

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CERTIFICATE OF SERVICE

I hereby certify that on the 24th day of February, 1999, a true and correct copy of the foregoing **REPLY TO OPPOSITION TO PETITION TO WAIVE THE RULES AND PROTEST** was served by first class mail to: Charles L. Gholz, at the following address: Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1755 Jefferson Davis Highway, Suite #400, Arlington, Virginia 22202.


H. Warren Burnam, Jr.